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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/462,925	06/02/2000	LIONEL JEAN	GEM-400	5660
21839	7590	11/10/2003	EXAMINER	
BURNS DOANE SWECKER & MATHIS L L P			ALI, AHMEDUR R	
POST OFFICE BOX 1404			ART UNIT	PAPER NUMBER
ALEXANDRIA, VA 22313-1404			2131	8

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

	Application No.	Applicant(s)
	09/462,925	JEAN ET AL.
	Examiner Ahmedur Ali	Art Unit 2131

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 02 June 2000.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-24 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 02 June 2000 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The application has been examined. Claims 1-24 are pending in this Office Action.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

3. The drawings are objected to by the draftsperson. A proposed drawing correction or corrected drawings are required in reply to the Office Action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

4. Claim 2-3 and 12 are objected to because of the following informalities: In claims 2-3 and 12 should have a colon after the word 'comprising'. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5, 7-15, and 17-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Tamada et al. U.S. Patent No. 4,879,645 ('Tamada' hereinafter). With respect to claim 1, Tamada disclose a method of managing a secure terminal used for transactions with smart cards (see abstract; Fig. 1), comprising:

placing a smart card in contact with the terminal (see Fig. 1; col. 1, lines 46-49);

executing a program by the terminal, this program including sensitive operations related to making the transactions secure (see col. 2, lines 32-40);

counting the number of times a request is made tot the terminal to execute sensitive operations (see col. 1, lines 36-43; col. 2, lines 54-62);

restricting the action of this terminal when this count reaches a predetermined value (see col. 1, lines 36-43; col. 4, lines 3-9).

7. Claim 2 rejected as above in rejecting claim 1, further comprising:

providing the terminal with a removable electronic security circuit (see Fig. 1; col. 2, lines 13-20), and

counting in this circuit, the number of requests for sensitive operations which are made to it or sensitive operations executed by it (see col. 2, lines 54-62).

8. Claim 3 rejected as above in rejecting claim 1, further comprising:
 - dividing the sensitive operations into a number of classes (see col. 3, lines 4-22)and;
 - establishing a count for each class (see col. 3, lines 23-37).
9. Claim 4 rejected as above in rejecting claim 1, further comprising:
 - executing a sensitive operation, a mutual identification procedure between the terminal and the card (see col. 2, lines 13-31).
10. Claim 5 rejected as above in rejecting claim 1, further comprising:
 - as a sensitive operation, performing an authentication (PIN) of a carrier of the smart card (see col. 2, lines 14-31).
11. Claim 7 rejected as above in rejecting claim 1 wherein the counter is re-initialized by a secure procedure including a verification of a secret code by the terminal or the security circuit (see col. 2, lines 32-44; col. 3, lines 29-37).
12. Claim 8 rejected as above in rejecting claim 7, wherein the secure procedure includes a verification of a secret code by the terminal or the security circuit (see col. 2, lines 32-44).
13. Claim 9 rejected as above in rejecting claim 7, wherein the re-initialization is performed remotely by a master system (see col. 2, lines 45-53; col. 3, lines 29-37).
14. Claim 10 rejected as above in rejecting claim 1, wherein the counter is incremented after a successful sensitive operation (see Fig. 4; col. 2, lines 54-62).

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15. Claim 11 rejected as above in rejecting claim 1, wherein for restricting, only some of the operations of the planned transaction are prevented (see col. 2, lines 54-62; col. 4, lines 10-25).
16. Claim 12 rejected as above in rejecting claim 1, wherein the management means is capable of identifying and counting requests coming from outside and restricting its functions as soon as the count reaches a predetermined number (see col. 2, lines 54-62).
17. Claim 13 rejected as above in rejecting claim 2, further comprising:
 - dividing the sensitive operations into a number of classes (see col. 3, lines 4-22)
 - and;
 - establishing a cont for each class (see col. 3, lines 23-37).
18. Claim 14 rejected as above in rejected claim 13, further comprising:
 - executing a sensitive operation, a mutual identification procedure between the terminal and the card (see Fig. 1; col. 1, lines 46-49; col. 2, lines 13-22).
19. Claim 15 rejected as above in rejecting claim 14, further comprising:
 - as a sensitive operation, performing an authentication (PIN) of a carrier of the smart card (see col. 2, lines 14-31).
20. Claim 17 rejected as above in rejecting claim 13, wherein the counter is re-initialized by a secure procedure including a verification of a secret code by the terminal or the security circuit (see col. 2, lines 27-44; col. 3, lines 29-37).

21. Claim 18 rejected as above in rejecting claim 17, wherein the secure procedure includes a verification of a secret code by the terminal or the security circuit (see Fig. 3; col. 2, lines 32-44).
22. Claim 19 rejected as above in rejecting claim 17, wherein the re-initialization is performed remotely by a master system (see col. 2, lines 45-53; col. 3, lines 29-37).
23. Claim 20 rejected as above in rejecting claim 13, wherein the counter is incremented after a successful sensitive operation (see col. 4, lines 19-25).
24. Claim 21 rejected as above in rejecting claim 13, wherein for restricting, only some of the operations of the planned transaction are prevented (see col. 2, lines 54-62; col. 4, lines 10-25).
25. Claim 22 rejected as above in rejecting claim 13, wherein the management means is capable of:
identifying and counting requests coming from outside and restricting its functions as soon as the count reaches a predetermined number (see col. 4, lines 10-25).
26. Claim 23 rejected as above in rejecting claim 19, wherein the counter is incremented after a successful sensitive operation (see Fig. 4; col. 2, lines 54-62).
27. Claim 24 rejected as above in rejecting claim 19, wherein for restricting, only some of the operations of the planned transactions are prevented (see col. 2, lines 54-62; col. 4, lines 10-25).

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claim 6 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tamada et al. U.S. Patent No. 4,879,645 ('Tamada' hereinafter) in view of Asad et al. U.S. Patent No. 6,539,093 ('Asad' hereinafter).

30. With respect to claim 6, Tamada teach all the limitations as above as indicated in claim 1.

Tamada does not disclose a sensitive operation, performing a verification of a certificate coming from a smart card.

However, Asad discloses a sensitive operation, performing a verification of a certificate coming from a smart card (see col. 3, lines 43-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Asad within the system of Tamada to arrive at the invention as claimed because both references are directed to placing a smart card in contact with a terminal, and because the implementation of performing a verification of a certificate of Asad in Tamada would further certify that the information coming from the smart card is authentic and that the card is authorized to access the terminal, further increasing the level of security and extending the capabilities of the combined system.

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30. With respect to claim 6, Tamada teach all the limitations as above as indicated in claim 13.

Tamada does not disclose a sensitive operation, performing a verification of a certificate coming from a smart card.

However, Asad discloses a sensitive operation, performing a verification of a certificate coming from a smart card (see col. 3, lines 43-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Asad within the system of Tamada to arrive at the invention as claimed because both references are directed to placing a smart card in contact with a terminal, and because the implementation of performing a verification of a certificate of Asad in Tamada would further certify that the information coming from the smart card is authentic and that the card is authorized to access the terminal, further increasing the level of security and extending the capabilities of the combined system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tanaka (U.S. Patent No. 5,845,069) discloses a card-type storage medium protecting data stored in its memory by interrupting an existing transaction after a predetermined permissible number of accesses.

Sarat (U.S. Patent No. 6,199,128) discloses a smart card system for use with peripheral devices.

Drupsteen et al. (U.S. Patent No. 5,856,659) disclose a method of securely modifying data on a smart card.

Matchett et al. (U.S. Patent No. 5,229,764) disclose a continuous

Everett et al. (U.S. Patent No. 6,328,217) disclose an integrated circuit card with application history list.

Sarat (U.S. Patent No. 6,151,647) discloses a versatile interface smart card.

Colnot (U.S. Patent No. 6,393,567) discloses a method of enabling a server to authorize access to a service from portable devices having electronic microcircuits, e.g. devices of the smart card type.

Murphy et al. (U.S. Patent No. 6,226,744) disclose a method and apparatus for authenticating users on a network using a smart card.

Pascal et al. (U.S. Patent No. 6,055,638) disclose a process and authentication device for secured authentication between two terminals.

Davis et al. (U.S. Patent No. 6,378,037) disclose a single account portable wireless financial messaging unit.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ahmedur Ali whose telephone number is 305-4667. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 305-9648. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

ara


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